



PATENT

Attorney Docket No: 102258.262

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Stamler, et al.

Serial No.: 09/092,622

Filed: June 5, 1998

For: NITROSATED AND NITROSYLATED HEME PROTEINS

Assistant Commissioner for Patents  
Washington, D.C. 20231

DECLARATION OF GRETCHEN A. RICE  
IN SUPPORT OF  
FILING UNDER 37 C.F.R. §1.47(a)

Sir:

The undersigned, Gretchen A. Rice, declares and states that:

1. I am an attorney of record for the above-identified patent application.
2. I am making this declaration based on first-hand knowledge of the facts surrounding the refusal of one of the joint inventors, Dr. Jonathan Stamler, to sign the Combined Declaration for Patent Application and Power of Attorney and Assignment for this application.
3. The above-referenced application is a continuation-in-part of USSN 08/409,720, filed March 24, 1995, now abandoned, which is a continuation-in-part of 08/198,854, filed February 17, 1994, now abandoned, which is a divisional of 07/943,835, filed September 14, 1992, now abandoned, which is a continuation-in-part of 07/791,668, filed November 15, 1991, now abandoned.
4. The specification of the above-referenced application is identical to the specification of USSN 07/943,835 and the claims of the above-referenced application are supported by the specification. The inventors of USSN 07/943,835, one of whom

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington D.C. 20231.

on Dec. 30, 1998

(Date of Deposit)

Karen Kenney  
Person Making Deposit  
Karen K  
Signature

was Dr. Stamler, executed an assignment on October 30, 1992 which assigned their entire right, title and interest in and to the invention to Brigham and Women's Hospital. Exhibit A is a copy of the assignment for USSN 07/943,835.

5. On or about December 13, 1993, Dr. Stamler left the employment of Brigham and Women's Hospital and took a position at Duke University, his present employer.

6. Exhibit B is a copy of a letter dated November 20, 1998 to Maxim H. Waldbaum, Esq., attorney for Duke University, from Gretchen A. Rice, requesting that he obtain the signature of Dr. Stamler on the Combined Declaration and Assignment. The letter explains that the specification of the above-referenced application is identical to the specification of a USSN 07/943,835, filed September 14, 1992, for which Dr. Stamler executed an assignment on October 30, 1992. A copy of the specification and claims for the above referenced application, a copy of the specification and claims for USSN 07/943,835, and a copy of the assignment for USSN 07/943,835 were all included with the November 20, 1998 letter.

7. Exhibit C is a copy of a facsimile letter from Maxim H. Waldbaum, Esq., dated November 24, 1998, stating among other things that "we will examine the entire file entire histories in the chain of this application before we answer you" and requesting a copy of all continuing prosecution not previously provided should be sent to him.

8. Exhibit D is a copy of my facsimile letter to Mr. Waldbaum, dated November 30, 1998, in which, among other things, I reiterated that Dr. Stamler was being asked to comply with the terms of his executed assignment and to execute a new assignment for the above-referenced patent application which was identical to USSN 07/943,835 for which Dr. Stamler had previously executed an assignment.

9. Exhibit E is a copy of a facsimile letter from Mr. Waldbaum, dated November 30, 1998, which replied to my letters of November 20 and 30, 1998 and to a letter regarding two other matters dated November 23, 1998. In his November 30, 1998 letter, Mr. Waldbaum stated among other things that "we will attempt to provide to

you a more detailed response to your November 20, 23 and 30, 1998 letters" (see page 2 of the letter in exhibit E) and requesting a copy of the pending claims corresponding to the applications.

10. Exhibit F is a copy of my facsimile letter to Mr. Waldbaum, dated December 2, 1998, except that the text of the letter which is directed at two unrelated matters has been redacted. In my December 2, 1998 letter, I stated among other things that the claims pending in the above-referenced application were provided with the letter of November 20, 1998. I also reiterated for the third time that Dr. Stamler was being asked to execute an assignment for the above-referenced patent application the specification of which application is identical to the specification of USSN 07/943,835, and reminding Mr. Waldbaum that Dr. Stamler previously executed an assignment to the Brigham and Women's Hospital for USSN 07/943,835.

11. Exhibit G is a copy of a facsimile letter from Mr. Waldbaum, dated December 16, 1998, except that the text of the letter which is directed at two unrelated matters has been redacted. In his December 16, 1998 letter, Mr. Waldbaum states, among other things, that Dr. Stamler believes that named inventors for the above-referenced application are not the proper inventors as Dr. Stamler believes that while working at Duke University he completed the work which he feels enables the claimed invention. Thus, Mr. Waldbaum asserts that Dr. Stamler is legally obligated to refuse to execute both of the Combined Declaration and Assignment.

12. Exhibit H is a copy of my facsimile letter to Mr. Waldbaum, dated December 19, 1998, in which I state among other things that the claims of the above-referenced application were fully enabled by the specification of USSN 07/943,835 to which the specification of the above-referenced application is identical, and that Mr. Waldbaum's letters would be submitted to the Patent Office as evidence of Dr. Stamler's refusal to execute the Combined Declaration and the Assignment.

13. On information and belief, Dr. Stamler has not signed the Combined Declaration or Assignment for the above-referenced patent application.

14. On information and belief, filing under 37 C.F.R. §1.47(a) is necessary to preserve the rights of the assignee, Brigham and Women's Hospital.

15. I declare further that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true, and further that the statements are made with the knowledge that wilful false statements and the like are punishable by fine or imprisonment, or both, under §1001 of Title 18 of the United States Code, and that such wilful false statements may jeopardize the validity of the patent application or any patent issuing thereon.

Respectfully submitted,

Dated: December 19, 1998

Gretchen A. Rice  
Gretchen A. Rice, Ph.D.  
Registration No. 37,429  
Hale and Dorr LLP  
60 State Street  
Boston, Massachusetts 02109  
Tel. No.: (617) 526-6000

/netuser13/rice/op/102258.262/1\_47decl.wpf